

REMARKS/ARGUMENTS

The election/restriction requirement (hereinafter the “Office Action”) dated October 20, 2008 has been considered. The Examiner contends that the claims are drawn to three inventions, namely Group I (Claims 1-25); Group II (Claims 32-37); and Group III (Claims 26-31 and 38-40, 32-37) and asserts that restriction to one of claim Groups I-III is required under 35 U.S.C. §121. The Applicants respectfully traverse the restriction requirement.

The claims of **Group I (Claims 1-25)** are provisionally elected with traverse. The Applicants traverse the requirement as failing to satisfy the requirements for maintaining such a restriction requirement. The Applicants request reconsideration and withdrawal of the restriction requirement.

In paragraph 7 of the Official Action, it is stated that the restriction is based upon subcombination not essential to combination. Applicant respectfully traverses the restriction and election requirements due to a failure to fully comply with the requirements set forth in the Manual of Patent Examining Procedure (MPEP), and respectfully requests reconsideration and withdrawal of the restriction and election requirements.

MPEP § 806.05(c) requires, among other things, identification of a combination and subcombination. The Examiner must establish two-way distinctness which involves establishing the following:

- 1) the “combination” does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and
- 2) the “subcombination” has utility either by itself or in another materially different combination.

The Examiner has identified Group I as the combination, and Groups II and III as the subcombinations. According to MPEP § 806.05(c), the Examiner must show that the combination (i.e., claims of Group I) does not require the particulars of claims of Groups II and III, and that the subcombinations (i.e. claims of Groups II and III) have utility either by itself or in another materially different combination.

The Examiner carries the burden to suggest an example of separate utility of each identified subcombination relative to the combination. However, the Office Action merely states that Claims 1-25 do not rely upon content provider containing Web pages that include

XML to define location information associated with the Web pages. The Office Action further states that Claims 1-25 do not rely upon a user interface to display menu options containing a general search option that returns content regardless of location tags, location search option, a user centric search option, etc.

It is respectfully submitted that the examples above merely show features of claims of Groups II and III that are not recited in the claims of Group I. While this may be intended to show that the purported combination does not require the particulars of the purported subcombination as claimed for patentability, this fails to show the purported subcombination has separate utility either by itself or in another materially different combination as required by the MPEP. Accordingly, Applicant requests that the Examiner document a viable separate utility or withdraw the requirement as is required under MPEP § 806.05(c).

Applicants, in traversing the Examiner's Restriction Requirement, is directing its arguments to the limited issue of the lack of proper grounds supporting the restriction of Applicants' claims for examination purposes. As such, Applicants' characterization of the claimed subject matter as it may pertain to the issue of distinctiveness or lack thereof within the context of restriction practice is not to be construed as an admission that the claimed inventions are obvious over each other within the meaning of 35 U.S.C. § 103.

In view of the above, the Applicant respectfully requests reconsideration and withdrawal of the restriction requirement to the claims of alleged Groups I-IV. If the Examiner would find it helpful to discuss this issue by telephone, the undersigned attorney of record invites the Examiner to contact the attorney of record.

Respectfully submitted,

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